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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,866	12/06/2000	Hideaki Yamanaka	200500US2	7895
22850	7590	05/20/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHARLES, DEBRA F	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/729,866

Applicant(s)

YAMANAKA ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Specification

1. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: on page 8, "the user can reduce the troublesomeness of the sending of the execution declaration" and page 10 "so there is no probability that the user fees a pain given by seeing an advertising information piece in which the user takes no interest". There is a great deal of non-standard English usage in the specification that impairs readability. The Examiner recommends the attorney re-write the specification in standard English.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber(U.S.PAT. 6289318 B1) and Flavin et al.(U.S.PAT. 6219788B1).

Re claims 1 and 2: Barber disclose a digital content system using a network, comprising:

an advertiser for possessing an advertising information piece to be provided for the user(col. 3, lines 23-50, col. 4, lines 1-20, 44-60); and

an administrator for obtaining the advertising information piece from the advertiser, receiving an execution declaration of the digital content from the user(col. 4, lines 15-43),

downloading the advertising information piece, collecting an advertisement rate, which corresponds to the number of execution times of the digital content used by the user, from the advertiser and paying an execution fee, which corresponds to the number of execution times of the digital content, to the holder(col. 9, lines 45-60, col. 10, lines 50-67).

Barber disclose(s) the claimed invention except a holder for having digital content and holding a right to let a third person use the digital content; a distributor for obtaining the digital content from the holder and distributing the digital content to a user; and a permission for the execution declaration to the user through the network. However, in Abstract, col. 4, lines 25-60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission. It would be obvious to one of ordinary skill in

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the art to modify the invention of Barber based on the teachings of Flavin et al.

The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input.

Re claim 3: Barber disclose(s) the claimed invention except the user uses the digital content by using the execution key downloaded to the user. However, in col. 5, lines 15-67 thereof, Flavin et al. disclose(s) a cryptographic key for use with the authentication process. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is to enhance the authentication process for content download.

Re claim 4: Barber disclose wherein the advertising information piece downloaded to the user is displayed in a time period between time periods in which the digital content is displayed in cases where the user uses the digital content(col. 3, lines 45-55, col.4, lines 40-60,col. 5, lines 10-40,col. 6, lines 1-67, i.e. advertisements shown in between content).

Re claim 5: Barber disclose wherein the distributor notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays a download charge, which corresponds to the number of download

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times of the digital content, to the distributor(Abstract, col. 7, lines 15-60, col. 8, lines 25-60, Claim 1).

Re claim 6: Barber disclose(s) the claimed invention except wherein the administrator downloads a plurality of advertising information pieces and the execution key, which permits the user to use the digital content prescribed times, to the user in cases where the administrator receives the execution declaration of the digital content from the user. However, in Abstract, col. 4, lines 25-60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input.

Re claims 7 and 8: Barber disclose(s) the claimed invention except the user uses the digital content by using an execution key downloaded from the administrator in the past while seeing an advertising information piece downloaded from the administrator in the past in cases where the execution key is not currently downloaded to the user from the administrator because of an abnormal state even though a prescribed time passes after the user sends the

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execution declaration of the digital content. And the user notifies the administrator that the user uses the digital content by using the execution key downloaded from the administrator in the past after the abnormal state is finished.

However, in Abstract, col. 3, lines 35-col. 4, lines 60, col. 5, lines 15-40 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input.

Re claim 9: Barber disclose wherein the advertising information piece downloaded from the administrator to the user corresponds to content of the digital content(col. 4, lines 1-15 and 45-60, i.e. pre-determined web site inherently means web site relates to advertising, and col. 5, lines 45-65, i.e. server is the administrator).

Re claims 10, 11, 14 and 15: Barber disclose wherein the administrator inquires the user of a genre of the advertising information piece to be downloaded to the user in cases, and the advertising information piece, of which a genre is selected by the user, is downloaded to the user; and wherein the administrator downloads

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the advertising information piece, which corresponds to content of another digital content used by the user in the past (col. 8, lines 1-50, i.e. customer selects website and object is retrieved from RPAS server for download, and cookie is downloaded).

Barber disclose(s) the claimed invention except where the administrator receives the execution declaration of the digital content from the user. However, in col. 4, lines 30-60, col. 8, lines 4-15 thereof, Flavin et al. disclose(s) information verifying the data distributed was received using a watchdog and the user selects the topic to search for web pages. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is to verify that data sent was received by the intended distribution authority.

Re claim 12: Barber disclose wherein the administrator collects the advertisement rate, which is determined according to a matching point between content of the digital content related to the execution declaration of the user and content of the advertising information piece downloaded from the administrator to the user, from the advertiser(col. 7, lines 55-67, col. 8, lines 5-54, col. 9, lines 45-60).

Re claim 16: Barber disclose(s) the claimed invention except which is notified by a network operator managing the network, to the user in cases where the administrator receives the execution declaration of the digital content from the

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user. However, in col. 7, lines 35-50, col. 8, lines 45-65 thereof, Flavin et al. disclose(s) a computer response that notifies the initial sending server that the distributed content has been received. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is the responsiveness of the network ensures sent items are received.

Re claims 17 and 19: Barber disclose an advertiser for possessing an advertising information piece to be provided for a user(col. 3, lines 23-50, col. 4, lines 1-20, 44-60);

a distributor for obtaining the digital content, in which the advertising information piece is included, from the holder and distributing the digital content with the advertising information piece to the user(col. 4, lines 15-43); and

notifying the advertiser of the number of execution times of the digital content used by the user, wherein the holder collects an advertisement rate, which corresponds to the number of execution times of the digital content used by the user, from the advertiser, and the holder pays a download charge, downloaded from the administrator to the user, to the administrator(col. 9, lines 45-60, col. 10, lines 50-67).

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Barber disclose(s) the claimed invention except a holder for receiving the advertising information piece from the advertiser, having digital content, which is set to become usable by an execution key, and holding a right to let a third person use the digital content; an administrator for obtaining the execution key from the holder, receiving an execution declaration of the digital content from the user, downloading the execution key to the user through the network; which corresponds to the number of download times of the execution key. However, in Abstract, col. 4, lines 25-60, col. 5, lines 15-67 thereof, Flavin et al. disclose(s) an authentication unit and process with watchdog to monitor and give access permission; and a cryptographic key for use with the authentication process. It would be obvious to one of ordinary skill in the art to modify the invention of Barber based on the teachings of Flavin et al. The motivation to combine these references is to validate a set of operations performed by the processing engine and transmitting an authenticating signal responsive to user input; and to enhance the authentication process for content distributed.

Re claim 18: Barber disclose wherein the distributor notifies the holder of the number of download times of the digital content downloaded to the user, and the holder pays a download charge, which corresponds to the number of download times of the digital content, to the distributor (Abstract, col. 7, lines 15-60, col. 8, lines 25-60, Claim 1).

All wable Subj ct Matter

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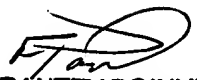
4. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantzy Poinvil can be reached on (703) 305-9779. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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FRANTZY POINVIL
PATENT EXAMINER
AU 3628

Debra F. Charles

Examiner

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